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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/603,832

06/26/2003

Tokimori Tomita

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EXAMINER

ALVAREZ, RAQUEL

ART UNIT

PAPER NUMBER

3688

MAIL DATE

DELIVERY MODE

02/10/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/603,832	TOMITA ET AL.	
	Examiner	Art Unit	
	Raquel Alvarez	3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14, 17, 20 and 23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4, 17, 20 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/31/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to communication filed on 11/17/2008.
2. Claims 14, 17, 20 and 23 are presented for examination.

Claim Objections

3. Claims 14, 17, 20 and 23 are objected to because of the following informalities:
Claims should be double spaced. Appropriate correction is required.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 14, 17, 20, 23 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deaton (6,684,195 hereinafter Deaton) in view of Humble (6,529,940 hereinafter Humble).

With respect to claims 14, 17, 20, 23 and 25 Deaton teaches a point management system employing a computer for managing points issued to each customer who receives a service according to the issued points with an electronic information service (Abstract). A point issue unit issues points to a customer according to a transaction performed by the customer (see Figure 18B and col. 75, lines 33-38); a

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point accumulation unit updates the issued points, in proportion to a time used for providing an information service according to the cumulative points (i.e. the incentives or points accumulated are based on the purchases made within a selected time period or whether the store has the product in inventory, the incentive may be changed)(Figure 18C, items 38,39,42,43, 46, col. 73, lines 45-57, col. 75, lines 33-38 and col. 103, lines 50 to col. 104, lines 1-21); service providing means for providing the information to a customer (col. 103, lines 64 to col. 104, lines 1-21).

Deaton doesn't specifically teach that the services provided are video information, voice information, software information, music information and database information as the electronic information to the customer through a communication circuit. Official notice is taken that it is old and well known in the computer related arts to provide services electronically such as video information, voice information, software, music and database information to the customer via the customer's PC in order to avoid the need for the customer to having to wait for the goods or services or having to pick up the goods or services from a remote location. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included providing services/items electronically such as video information, voice information, software, music and database information via his or her PC in order to obtain the above mentioned advantage.

With respect to calculating and decreasing the cumulative points for a time when the information service is provided to a customer. Deaton teaches on Figure 33,

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redeeming the coupons (i.e. decreasing the cumulative points) when the items are bought and received by the customer at the point of sale.

Deaton doesn't specifically teach displaying the points that are decreased when an information or service is provided to the customer terminal. Humble teaches on Figure 1 displaying at the checkout or POS when an item is being purchased, a visual aid of what is taken place such as issuing a coupon on display 26. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included in the system of Deaton displaying the decreased of points at the time the information is provided or at the time of sale of Humble because such a modification would provide **"visual presentation to the customer"**(in Humble col. 2, lines 45-48) .

Response to Arguments

6. Applicant argues that Deaton doesn't teach decreasing the cumulative points on a time by time basis with a time when an electronic information service is provided to a customer terminal. The Examiner disagrees with Applicant because Deaton teaches on Figure 33, redeeming the coupons (i.e. decreasing the cumulative points) when the items are bought and received by the customer at the point of sale.

7. Applicant argues that Deaton doesn't teach displaying the decreased customer's cumulative points on a screen of the customer terminal during the time the electronic information service is provided to the customer terminal, the Examiner wants to point that Deaton wasn't cited for teaching the above limitations but Humble was cited for

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teaching on Figure 1 displaying at the checkout or POS when an item is being purchased, a visual aid of what is taken place such as issuing a coupon on display 26 and therefore the claims should be argued accordingly.

8. With respect to the Official Notice taken that it is old and well known in the computer related arts to provide services/products electronically such as video, software and the like, the Examiner has provided examples of the well known facts and Appellant hasn't provided a proper challenge that would at least cast reasonable doubt that the known facts weren't known (providing electronic information or services such as video, software etc.) prior to Applicant's invention priority filed on April 9, 1993. See MPEP 2144.03.

9. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Point of contact

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (571)272-6715. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James w. Myhre can be reached on (571)272-6722. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Raquel Alvarez/
Primary Examiner, Art Unit 3688

Raquel Alvarez
Primary Examiner
Art Unit 3688

R.A.
2/6/2009